

U.S. Appln. No. 09/844,086  
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## REMARKS

Claims 1-20 stand rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter that applicants regard as their invention. Specifically, the Official Office Action states that in claim 1 "a plurality of at least six" is awkward, it is not clear what sample is intended by "solids or mixtures of solids", and it is not clear what is intended by "adsorbate". With respect to claim 3, the Official Office Action states that "value, relative or absolute" is confusing. Applicants traverse the rejection and assert that the claims do particularly point out and distinctly claims the subject matter which the applicants regard as their invention and that one of ordinary skill in the art would readily understand what is intended by the cited phrases.

However, for the sake of expediency only, applicants have amended the claims to provide even greater clarity. As suggested in the Official Office Action, applicants have dropped the phrase "a plurality of" to clarify Claim 1. Also, the phrase "mixtures of solids" was deleted. It is clear from definition in paragraph 13 of the specification that the term "solids" is meant to include mixtures of solids and hence the phrase could be deleted from Claim 1 without in any way limiting the scope of the claim. The last sentence of paragraph 18 reads, "When the term "solid" is used herein, it is meant to include the situation where the "solid" is a mixture of two or more solids as well as when the "solid" is an individual solid material." Claims depending from Claim 1 were amended to conform with the changes in Claim 1. No new matter was added by the amendments.

With respect to the term "adsorbate", applicants point to paragraph 21 of the specification. Lines 23-27 of page 8 state "...the general term "adsorbate" refers to a fluid that may be adsorbed by one or more of the solids. In fact, however, one or more of the solids in a plurality may not interact with the "adsorbate" at all, and so the term "adsorbate" as used periodically herein is meant to include fluid with the potential or possibility of being adsorbed by the solids." One of ordinary skill in the art would therefore understand the adsorbate

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of Claim 1 to be a fluid that has the potential of being adsorbed by the solids and the term is not indefinite as used in Claim 1.

Claim 3 was amended to clarify that the surface property determined for each solid are compared to one another or to a standard. The amendments to Claims 1 and 3 operate to cure the rejection promulgated under 35 U.S.C. §112 second paragraph and applicants request that the rejection be withdrawn. No new matter has been added by these amendments.

Claims 1-20 also stand rejected under 35 U.S.C. §102(b) as being anticipated by WO 98/15813. Applicants traverse the rejection and assert that each and every element of applicants' claimed invention is not taught in the cited reference.

The Official Office Action states that the WO 98/15183 reference teaches a method of evaluating samples using thermal imaging and infrared spectroscopic imaging by placing the sample on a substrate. The action state the samples could be solids and the number of reaction wells shown is 15. The substrate is a flat or semi-rigid surface. The results of mixing the sample with the catalyst are compared to a library imaging/spectroscopic data to identify the samples.

In contrast to the cited reference, applicants' invention involves supporting the solids on at least one support and contacting the solids with an adsorbate while measuring the radiation emitted absorbed or altered by each of the solids using a detector. At least one surface property of each of the solids is determined using the radiation measurements, see Claim 1. WO 98/15183 fails to teach contacting the solids with an adsorbate and monitoring changes in radiation in order to determine a surface property of each solid.

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With the cited reference failing to teach express elements of applicants' claimed invention, the *prima facie* case of anticipation has not been established and applicants' request that the rejection promulgated under 35 U.S.C. §102(b) be withdrawn. Accordingly, in view of the above amendments and remarks, this application is now believed to be in a condition for an allowance of all claims and such action is respectfully requested.

Respectfully submitted,



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